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John P. Downs

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN P. DOWNS

Appeal 2009-009496
Application 10/770,139
Technology Center 1700

Before JAMES T. MOORE and ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judges*, CHUNG K. PAK, CHARLES F. WARREN, and PETER F. KRATZ, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

Appellant requests rehearing of the Decision of January 29, 2010, wherein the Examiner's decision to reject all the appealed claims under 35 U.S.C. § 103(a) is affirmed. An expanded panel has been designated to decide the requested rehearing.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304 begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

We have reconsidered the Decision in light of the contentions advanced in Appellant's Request for Rehearing ("Request", filed March 25, 2010), but we decline to make any change thereto.

SUMMARY OF REQUEST

It is asserted at pages one through three of the Request that the Decision requires correction because the original panel treated the Examiner's position as presumptively correct in phrasing the issue(s) and did not consider the record as a whole including Appellant's arguments in rendering its Decision.² It is also contended in the Request that:

(1) the original panel improperly shifted the burden to Appellant to produce evidence and/or persuasive argument to show that the adhesive-dispensing tape made in accordance with the teachings of Torrey would not be capable of carrying out Appellant's claimed intended use or function of individually exposing and dispensing of the non-contiguously arranged and spaced pressure-sensitive adhesive segments located on Torrey's transfer tape to an abutting planar surface by transverse flexing of the carrier tape; and

(2) the original panel improperly invoked "common sense" without explanation of the facts being relied upon to establish the common sense attributable to an ordinarily skilled artisan at the time of the invention.

DISCUSSION

In any request for rehearing, Appellant must state with particularity each point of law or fact they believe was overlooked or misapprehended in

² See related Appeal Nos. 2009-007259, 2009-013093, and 2009-015130.

the Decision. Any new argument in a request for rehearing is untimely and inappropriate. *See* 37 C.F.R. § 41.52.

We disagree as to all of the specific items identified in the Request, which are argued as requiring a new Decision. We take them up generally in the order set forth above.

At the outset, we disagree with Appellant's incorrect assertions to the effect that the original panel failed to consider the record as a whole, including Appellant's arguments, and instead treated the Examiner's position as presumptively correct in rendering its Decision (Req. 1-3). As correctly observed by Appellant, "the [E]xaminer bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). However, "[t]he '*prima facie* case' serves as a procedural mechanism that shifts the burden of going forward to the applicant, who must produce evidence and/or argument rebutting the case of unpatentability" (internal citations omitted). *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

An appellant may attempt to overcome an examiner's obviousness rejection on appeal to the Board by submitting arguments and/or evidence to show that the examiner made an error in either (1) an underlying finding of fact upon which the final conclusion of obviousness was based, or (2) the reasoning used to reach the legal conclusion of obviousness. Similarly, the applicant may submit evidence of secondary considerations of non-obviousness [(internal citation omitted)].

Id.

In general, the Board will not reach the merits of matters that an appellant did not contest. *Id.* at 1075-76. *See, e.g., Shinseki v. Sanders*, 129 S.Ct.

1696, 1706 (2009) (citations omitted) (“Lower court cases make clear that courts have correlated review of ordinary administrative proceedings to appellate review of civil cases in this respect. . . . [T]he party seeking reversal normally must explain why the erroneous ruling caused harm.”) *See also, In re Chapman*, 595 F.3d 1330, 1338 (Fed. Cir. 2010) (discussing the role of harmless error in appeals from decisions of the Board of Patent Appeals and Interferences (“Board”)). Arguments not timely made have been waived. 37 C.F.R. § 41.37(c)(1)(vii) (second sentence); *see also In re Hyatt*, 211 F.3d 1367, 1373 (Fed. Cir. 2000) (an argument not first raised in the brief to the Board is waived on appeal).

Against this backdrop, Appellant’s argument that the original panel was treating the Examiner’s position to be presumptively correct by the phrasing of the principal issue identified in the Decision is conjectural at best. While unnecessary to our disposal of this contention on rehearing, we note that the issue statement in the Decision reflected the arguments that Appellant focused on in the Appeal Brief and Reply Brief concerning the functional language appearing in each of independent claims 1, 7 and 16 as a basis for asserting that the Examiner failed to present a prima facie case of obviousness (Dec. 3 and 6-10; App. Br. 8-17; Reply Br. 2, 3, and 5). Moreover, the factual findings set forth in the Decision substantiate that the record was considered as a whole, including the relevant evidence, giving due consideration to the arguments advanced by Appellant in the Appeal Brief and the argument raised in response to the Examiner’s Answer in the Reply Brief.

Concerning identified item No. 1 set forth above, we disagree with the allegations in the Request asserting that an improper shifting of the burden

to Appellant of going forward with argument and/or evidence was advanced by the original panel in the Decision.

The Examiner found several significantly relevant common features between the adhesive-dispensing tape made in accordance with the teachings of Torrey and the tape of Appellant. For example, the Examiner found that the carrier tape of Torrey, like Appellant's tape, is flexible and can be made from a material such as polyester and includes release surfaces. The Examiner also found that Torrey teaches that its pressure sensitive adhesive segments, like Appellant's adhesive segments, can be spaced apart (non-contiguously arranged) on the carrier tape between the edges thereof with any portion of the adhesive being transferrable from the carrier tape to a substrate (Ans. 3-4; Spec. para 0006). Based on these common features, the Examiner reasonably determined, and the original panel agreed, that the adhesive-dispensing tape taught or suggested by Torrey includes all of the necessary structures capable of carrying out Appellant's claimed function or intended use (function of individually exposing and dispensing the non-contiguously arranged and individually spaced apart pressure-sensitive adhesive segments located on Torrey's transfer tape to an abutting planar surface by transverse flexing of the carrier tape) (Ans. 3, 4, and 6; Dec. 3 and 7-10). *See also In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *In re Best*, 562 F.2d 1252, 1255-56 (CCPA 1971). Thus, the burden was with Appellant to show that the adhesive dispensing tape of Torrey does not necessarily possess Appellant's claimed function or intended use or Appellant's claimed function or intended use renders the claimed adhesive dispensing tape structurally different from that of Torrey. Appellant did not carry that burden.

For the reasons stated in the Decision and the portions of the disclosure of Torrey cited to therein, we disagree with Appellant's unsupported contention that there is insufficient detail in the disclosure of Torrey for Appellant to be saddled with the burden of providing evidence or a persuasive technical rationale to show that Appellant's claimed function or intended use renders the claimed adhesive dispensing tape patentably different from that taught by Torrey.

On this record, Appellant has not persuasively explained why it would not be reasonable to expect that a tape, made in accordance with the teachings of Torrey for the purpose of dispensing multiple segments of adhesive, while using individual spaced apart adhesive segments, from a flexible carrier tape with a release surface, would not have been capable of dispensing an individual adhesive segment of Torrey to an abutting planar surface (substrate). In this regard, the reference to the drawings of Torrey as failing to show particular proportions or sizes of elements is unavailing on this appeal record. This is because Appellant has not argued that a particular adhesive segment size, transfer tape dimension, and/or adhesive segment spacing is critical to achieving the broadly claimed intended use/function. After all, Torrey teaches that the adhesive segments can be individually spaced apart from each other and may be of varying sizes suited for the particular purpose for which the adhesive is to be used as set forth in the portions of Torrey referenced in the Decision.

Appellant also has not produced evidence and/or technical reasoning to show why the individually spaced apart adhesive segments of Torrey would not be expected to function as Appellant's spaced apart segments. Consequently, it is not apparent to us that additional structure over that

provided for by the transfer tape taught and/or suggested by Torrey is required by Appellant's intended use or functional limitation. *See In re Schreiber*, 128 F.3d at 1477 ("It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.").

Concerning item No. 2, as identified above, Appellant does not point to anything in the record that the original panel misapprehended or overlooked in additionally agreeing with the Examiner's obviousness position based on the teachings and suggestions derived from Torrey as noted in the Decision and in accordance with the statutory law of obviousness as explained by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). Rather, Appellant generally implies that the original panel improperly invoked "common sense" without furnishing any explanation of the facts being relied upon (Req. 7).

However, the facts relied upon are explicitly set forth in the Decision and/or are presented by way of reference to cited portions of the record in the Decision (Dec. 7, 8, 10, and 11).

The original panel did not invoke common sense in an improper manner to bridge a gap in the prior art evidence and/or without explanation of the underlying facts relied upon to arrive at a conclusion of obviousness. Rather, the original panel took into account the specific teachings of Torrey and the inferences which one skilled in the art would reasonably be expected to draw from Torrey's disclosure. *In re Preda*, 401 F.2d 825, 826-827 (CCPA 1968). It is skill in the art, rather than the converse, which is to be presumed. *In re Sovish*, 769 F.2d 738, 742-743 (Fed. Cir. 1985). In this regard, even if Torrey were not considered to implicitly teach a tape that has

an individual adhesive segment dispensing capability, a proposition with which the original panel disagreed, the original panel was satisfied that the adhesive segment shape and spacing alternatives taught by Torrey would have otherwise led an ordinarily skilled artisan to the construction of a transfer tape with adhesive segments spaced, as claimed, that permits individual as well as multiple adhesive segment dispensing options.

Thus, in referring to “common sense”, the original panel merely indicated, as an additional matter, that “common sense” of an ordinarily skilled artisan buttresses the obviousness conclusion properly reached by the original panel from the applied prior art teachings (Dec. 10-11). In this regard, in considering the obviousness of Appellant’s claims, the original panel was not limited to the particular problem Torrey may have solved in assessing the reach of Torrey’s teachings and suggestions with respect to adhesive dispensing tape constructions for dispensing any portion of the adhesive segments as would have been understood by one of ordinary skill in the art .

“Common sense has long been recognized to inform the analysis of obviousness if explained with sufficient reasoning” *Perfect Web Technologies, Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328-29 (Fed. Cir. 2009). In *KSR*, the Court confirmed this long-standing principle, further clarifying that a properly flexible obviousness inquiry may take into account

market forces; design incentives; the “interrelated teachings of multiple patents”; “any need or problem known in the field of endeavor at the time of invention and addressed by the patent”; and the background knowledge, creativity, and common sense of the person of ordinary skill.

Id. at 1329 (quoting *KSR*, 550 U.S. at 418-21).

CONCLUSION

We are of the opinion that the original panel correctly concluded upon consideration of all of the evidence and argument of record that it would have been obvious within the meaning of 35 U.S.C. § 103(a) for one of ordinary skill in the art to arrive at the claimed subject matter from the applied prior art for reasons stated in the Decision and as set forth by the Examiner in the Answer.

ORDER

We have granted Appellant's Request to the extent we have reconsidered the Decision as indicated above, but we decline to make any substantive change therein.

DENIED

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